

REMARKS

Claim Amendments

Upon entry of these amendments, claims 8-16 are pending. Applicants cancel claim 7 without prejudice or disclaimer, and amend claims 9-11 and 13-15 merely to remove their dependence on that canceled claim. Because this Amendment merely cancels a claim, it does not raise new issues, present new matter, or require any additional search of the art. Therefore, this Amendment should allow for immediate action, and Applicants respectfully request its entry under 37 C.F.R. § 1.116.

Furthermore, entry of the Amendment would place the application in better form for appeal, should the Office dispute the patentability of the pending claims.

Rejection of Claims 7 and 10-16 is Moot

The Office rejects claims 7 and 10-16 under 35 U.S.C. § 112, first paragraph, asserting that the recitation of “prophylaxis” in claim 7 and its dependents renders those claims not enabled. (Office Action at page 2.) This rejection is moot, upon entry of the claim amendments, as Applicants cancel claim 7 and amend the dependent claims to remove their dependence on claim 7.

In any event, Applicants reiterate that prophylactic treatment is simply one type of treatment, such as that given to an individual suspected of suffering from, or at risk of suffering from, angiogenesis or arteriogenesis.

Claim 8 is Definite

The Office also asserts that the phrase: “treating a disorder characterized by angiogenesis or arteriogenesis” renders claim 8 and its dependents indefinite under 35

U.S.C. § 112, second paragraph. The Office's only rationale is that changing this phrase to recite "characterized by," instead of "caused by," a term the Office also objected to, "indicates a different level of impact for angiogenesis/arteriogenesis in the disease to be treated from an initiating event to a symptom." (Office Action at page 3.)

Yet, definiteness is judged from the position of one of ordinary skill in the art, rather than from the position of the Office. Those in the art recognize that angiogenesis and arteriogenesis can be both symptoms as well as initiating events. For example, in cancer, these processes may not cause cancer cells to form, but they mediate the ability of resulting tumors to grow or spread, and therefore, can directly control the severity of the disease. Thus, the meaning of a disorder "characterized by angiogenesis or arteriogenesis" is perfectly clear to those of ordinary skill in the art.

Thus, Applicants request the withdrawal of this rejection and the allowance of claims 8-16.

CONCLUSION

As these remarks illustrate, claims 8-16 are in condition for allowance. Applicants therefore request the entry of this Amendment under 37 C.F.R. § 1.116, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any required fees not found herewith or otherwise accounted for to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 10, 2004

By: Elizabeth A. Doherty
Elizabeth A. Doherty
Reg. No. 50,894